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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/054,331

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Collin A. Rich

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7590

12/17/2003

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EXAMINER

OEN, WILLIAM L

ART UNIT

PAPER NUMBER

2855

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,331

Applicant(s)

RICH ET AL.

Examiner

William L Oen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 & 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Specification

The title of the invention is not descriptive in that only a *few* of the claims are directed to a *capacitive* type device. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-8, and 11-25, and 31-35 rejected under 35 U.S.C. 103(a) as being unpatentable over either Neukermans (U.S. Patent No. 6,068,589), Lesinski et al. '787 (U.S. Patent No. 5,531,787), or Lesinski et al. '859 (U.S. Patent No. 5,984,859), in view of either Zavracky (U.S. Patent No. 5,509,280), Mosser et al. (U.S. Patent No. 5,081,437), or Ugai et al. (U.S. Patent No. 5,259,248).

Neukermans, Lesinski et al. '787, and Lesinski et al. '859 each explicitly teaches all of the essential features of the claimed implantable micro-fabricated sensor device including a substrate with a sensor integrally formed thereon, and in turn a conductive path formed on the substrate and sensor, as well as active circuitry close to and electrically connected to the sensor. It is noted that Neukermans, Lesinski et al. '787, and Lesinski et al. '859 do not explicitly teach that the sensor is a cap layer formed of boron doped silicon. Zavracky, Mosser et al., and Ugai et al., in the same field of endeavor as Neukermans, Lesinski et al. '787, and Lesinski et al. '859, teach micro-fabricated sensors that do (at least *inherently*) teach devices wherein their respective sensors can be a cap layer formed of boron doped silicon. In view of the teaching by Zavracky, Mosser et al., or Ugai et al., it would have been obvious to one having ordinary skill in the art at the time of the invention to have formed in the implantable micro-fabricated sensor systems of either Neukermans, Lesinski et al. '787, or Lesinski

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et al. '859, the sensor as a cap layer formed of boron doped silicon, if desired. This is further obvious because such a modification would be simple and expeditious. Further, capacitive type sensors are notoriously well known in the sensor micro-fabrication art.

Claims 2, 9, 10, and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Neukermans (U.S. Patent No. 6,068,589), Lesinski et al. '787 (U.S. Patent No. 5,531,787), or Lesinski et al. '859 (U.S. Patent No. 5,984,859) in view of Zavracky (U.S. Patent No. 5,509,280).

Neukermans, Lesinski et al. '787, and Lesinski et al. '859 each explicitly teach all of the essential features of the claimed implantable micro-fabricated sensor device including a substrate with a sensor integrally formed thereon, a conductive path formed on the substrate and sensor, and active circuitry in proximity to and electrically connected to the sensor. It is noted that neither Neukermans, Lesinski et al. '787, nor Lesinski et al. '859 explicitly teach that the sensor is a capacitive type sensor, per se.

Zavracky, in the same field of endeavor as Neukermans, Lesinski et al. '787, and Lesinski et al. '859, however, does explicitly teach a micro-fabricated sensor that is operative as a capacitive type sensor (see, e.g., col. 10 of Zavracky). In view of this explicit teaching by Zavracky, and because it would involve but a simple & expedient substitution, it would have been obvious to one having ordinary skill in the art at the time of the invention to have formed the sensor of Neukermans, Lesinski et al. '787, or Lesinski et al. '859 as a capacitive type sensor, if desired.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L Oen whose telephone number is (703) 308-5161. The examiner can normally be reached on 10:30 am - 9:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Lefkowitz can be reached on 703-305-4816. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-4900.



William L Oen
Primary Examiner
Art Unit 2855

WL Oen
13 December 2003